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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,915	01/10/2001	Jay Stone	30020-pa	8320
7590	10/07/2003		EXAMINER	
BERNHARD KRETN, ESQ. & ASSOCIATES 300 CAPITOL MALL, SUITE 1100 SACRAMENTO, CA 95814				RADA, ALEX P
		ART UNIT	PAPER NUMBER	3714

DATE MAILED: 10/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/757,915	STONE, JAY
	Examiner	Art Unit
	Alex P. Rada	3714

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3, 6-13 and 15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 6-13 and 15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 28 April 2003 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Response to Amendment

In response to the amendment filed April 28, 2003 in which the applicant provides drawing corrections, amends claims 1, 10-13, 15-17, 19, 20, and 22 adds new claim 23, and claims 1, 3, 6-13, and 15-23 are pending in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 6-13, and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessho '169 in view of Arnold (GB) '781.

3. Bessho discloses a display (3), a plurality of decision making means (figure 2), a wagering means (figure 2), a processor including a random means (figure 2), a display for including a plurality of symbols oriented in an RXC matrix (figure 1), and a processor including means to change the location of one or more symbol if the first outcome is not recognized by the payable such that the one or more symbols move from their first outcome orientation to a different area in the RXC matrix to provide a second outcome recognized by the comparison means to be on the table (column 1, line 66 – column 4, line 67) as recited in claims 1, 15, 16, 19, 20, and 22-23. The symbols only move from the first outcome orientation to an area within the same row or column, subset, and one specific column of the matrix (column 1, line 66 – column 4, line 67) as recited in claims 3, 6, 7, and 21. The number of predetermined number of symbols necessary for a winning outcome and recognized by the

paytable (column 1, line 66 – column 4, line 67) as recited in claims 8 and 9. The outcome is recognized by the highest-ranking and lowest-ranking combination on the paytable of possible combinations of symbols of the first outcome orientation (column 1, line 66 – column 4, line 67) as recited in claims 11 and 12. The location of one or more symbol is not recognized by the paytable is active during all times of operation and not active during all times of operation (column 1, line 66 – column 4, line 67) as recited in claims 12 and 13. Bessho does not expressly disclose a processor-activated means to bestow an award if the first outcome is recognized on the paytable as recited in claims 1, 15, 16, 19, 20, and 22-23.

Arnold teaches a fruit machine having the equivalent means (processor-activated means) to award if the first outcome is recognized on the paytable (page 1, line 107 – page 2, line 111). By having a means to award if the first outcome is recognized on the paytable, one of ordinary skill in the art would be able to give game players a second chance at an outcome. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bessho to include a means to bestow an award if the first outcome is recognized on the paytable as taught by Arnold, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art (*In re Venner*, 120 USPQ 192). To do so would provide game a second chance at a bigger payout outcome.

In regards to claims 17 and 18, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide different types of indicia because Applicant has not disclosed that the symbols are derived from a convention deck of playing cards and the symbols include a means to change and the symbols derived from the faces of dice provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art,

furthermore, would have expected Applicant's invention to perform equally well with any type of indicia as taught by Bessho in view of Arnold because any or different types of indicia would provide the same function and payout outcome regardless of shape, size, or color.

Response to Arguments

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is found in the reference of Arnold GB '781 as a secondary chance or the opportunity for a winning outcome. Both Bessho and Arnold do not expressly disclose a processor-activated means. Both Bessho in view of Arnold disclose the equivalent means to applicant's processor-activated means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bessho in view Arnold to include a processor-activated means, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art (*In re Venner*, 120 USPQ 192).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

APR
apr


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700